

REMARKS

Claims 1-4 and 8-9 are pending in the present application. Claim 1 was amended to more clearly define the limitations. The Applicant request reconsideration of the rejections based on the following remarks.

Before addressing the outstanding rejections, the Applicant notes that the Information Disclosure Statement filed with the application on July 25, 2001, still appears to have not been considered. While the IDS was acknowledged in form PTO-326, the Applicant did not receive a copy indicating that the references were considered. Accordingly, the Applicant respectfully requests that a copy of the PTO Form 1449 be included with the next Office Action.

Claim 1 was rejected under 35 U.S.C. §112 for indefiniteness. In light of the present amendment, the Applicant respectfully submits that the rejection is now moot and should therefore be withdrawn.

Claims 1-7 and 9-11 were rejected under 35 U.S.C. §103 (a) as being anticipated by Miner et al. (U.S. Patent No. 6,047,053) in view of Liffick (U.S. Patent No. 6,421,439). The Applicant respectfully traverses this rejection for the following reasons.

Specifically claim 1, features “the schedule store being administered by an appointments book program operated on a computer that is arranged outside a communication network by which the person seeking communication and the communication partner can be connected.” This limitation is not taught by Miner, as miner teaches that any scheduling or appointment calendar programs are only operated on devices belonging to a particular communication network and not outside of that network. This was acknowledged by the Examiner in the Office Action dated December 15, 2003.

However, the Examiner then went further to claim that Liffick teaches this limitation by broadly citing to reference 136 from FIG. 2, as well as column 6. Nevertheless, Liffick also fails to teach this limitation, as Liffick only discloses an “affiliation list” (150) which simply filters incoming calls that are directed toward the destination telephone 104 (col. 8, lines 36-37). The filters are based off of a forward list (160), a reverse list (162) a block list (164) and an allow list (166) associated with Internet subscribers. The affiliation list disclosed in Liffick is materially different from limitation cited above as there is no teaching of the “schedule store” being administered by an “appointments book program” recited in claim 1.

Furthermore, there is no suggestion or motivation to combine the Miner and Liffick references. Again, the Examiner broadly concluded that "it would have been obvious . . . to modify Miner with the computer taught by Liffick. This modification allows for a schedule store to be accessed via the Internet as suggested by Liffick." However, this rationale is simply incorrect. Miner already discloses the use of computer networks and databases including WANs and LANs (e.g., FIG. 5, ref. 104). Under what reasoning would one of ordinary skill in the art be motivated to use the Internet in the way suggested by the Office Action? To establish a prima facie case of obviousness, "either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227, USPQ 972, 972 (Bd. Pat. App. & Inter. 1985) (MPEP 2143). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teaching is proper (see MPEP 2143). The Applicant respectfully submits that the Office Action failed to explain why the combination was proper. Accordingly, the Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 1.


With respect to dependent claims 2-4 and 8-9, these claims are believed to be allowable at least by virtue of their dependency on independent claim 1. In light of the foregoing comments, the Applicant respectfully submits that the application is in condition for allowance and requests that a timely Notice of Allowance be issued in this case.

The Applicant wishes to make note that this response was filed within the three-month time period specified in the Office Action, as February 16, 2004 was a Federal holiday. Should there be any other charges regarding this application, the Examiner is hereby authorized to charge Deposit Account 02-1818 for any insufficiency of payment.

Respectfully submitted,

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